

DOCKET NO.: 3822-005-27

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF:	Michael L. PALMER	ART UNIT:	2143
SERIAL NO.:	10/006,236	EXAMINER:	David E. England
FILING DATE:	December 10, 2001		
FOR:	NEWS AND OTHER INFORMATION DELIVERY SYSTEM AND METHOD		

PRE-APPEAL BRIEF REQUEST FOR REVIEW

COMMISSIONER FOR PATENTS
PO BOX 1450
ALEXANDRIA, VA 22313-1450

SIR:

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a Notice of Appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the:

- ☐ applicant/inventor.
☐ assignee of record of the entire interest.
 See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
☒ attorney or agent of record.
 Registration No.: 41,828
☐ attorney or agent acting under 37 CFR 1.34.
 Registration number if acting under 37 CFR 1.34 _____

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*

- ☒ *Total of 5 forms are submitted.

Respectfully submitted,

DLA PIPER US LLP

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF: Michael L. PALMER ART UNIT: 2143
SERIAL NO.: 10/006,236 EXAMINER: David E. England
CONFIRMATION NO.: 9952
FILING DATE: December 10, 2001
FOR: NEWS AND OTHER INFORMATION DELIVERY SYSTEM AND
METHOD

PRE-APPEAL BRIEF REQUEST FOR REVIEW

COMMISSIONER FOR PATENTS
PO BOX 1450
ALEXANDRIA, VA 22313-1450

SIR:

Applicant hereby requests, pursuant to the pilot program described at 1296 Off. Gaz. 67 (July 12, 2005, as extended on January 11, 2006), pre-appeal brief review of the outstanding rejection of claims.

Claims 54-82 are pending in the application. Claims 54-65, 67, 69-80 and 82 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,415,307 ("Jones"), and claims 66, 68 and 81 stand rejected over Jones and U.S. Patent No. 6,463,461 ("Hanson"). Applicant respectfully requests review of these rejections.

Claim 54 is directed toward a method for "dynamically updating a content list at an end user location." The content list "comprises a plurality of stories and an ordered list of the stories, wherein each story comprises at least one text element, metadata, and zero or more references to a media object." Claim 54 recites the steps of:

receiving a content list from a feed station at a field station;
transmitting a copy of the content list from the field station to an end user station;
receiving a message from the feed station at the field station, the message comprising at least one revision to the content list;
implementing the revision to the content list at the field station; and
transmitting the revision to the end user station for revision of the content list at the end user station.

As discussed in the request for reconsideration dated June 7, 2007, Applicant respectfully submits that Jones does not disclose or suggest the steps of “implementing the revision to the content list at the field station” and “**transmitting the revision** to the end user station for revision of the content list at the end user station” (emphasis added). The transmission of the revision rather than an entire content list to the end user station is advantageous because it saves valuable bandwidth.

In contrast to claim 54, Jones discloses a system in which an entire content list is transmitted several times throughout the day. Jones discloses at column 2, lines 43-52, that a list of content of the pages of the publication can be displayed. The list of content for each page is displayed such that the passages of text (articles or stories) are listed in the order of importance, which can be attached to them by the way in which they are formatted on the page of the publication by the editors. When such content lists are to be updated, it appears Jones teaches regenerating the list of content associated with a publication, and *retransmitting the entire publication* rather than revising the content list as recited in the currently pending claims. As one example, column 2, line 61- through column 3, line 5 of Jones discloses rapidly obtaining each publication from the publisher, and rapidly updating the publication in response to each new edition. Updating the publication in response to a new edition suggests that an entire new edition, rather than just revisions to the previous edition, is received. This understanding is reinforced by the passage at col. 5, lines 26-45. This passage discusses the series of steps that are performed to group the various text and images on the pages of a publication into stories. This passage states that this grouping function is performed

for each edition of a newspaper that is published in a single day: “in the case of a newspaper for which there are several publications in a day, this process must be carried out [sic, for] each publication as quickly as possible in order that the information can be made available to users without delay.” Col. 5, lines 41-45. In other words, each time a new edition of the publication is received, each of the pages is examined to determine what text and pictures belong to which story. This re-transmission of an entire publication is exactly what the method of claim 54 avoids by transmitting *revisions* to a content list rather than re-transmitting the content list.

The final office action does not contest applicant’s characterization of Jones. Rather, the final office action posits a scenario in which a user of the applicant’s invention wishes to view “all new data.” Under this scenario, “that would mean that the entire list must be revised and therefore the entire content list is re-transmitted to the user.” The office action asserts that this is “a match” to Jones and therefore Jones anticipates claim 24. Final office action, pp. 7-8.

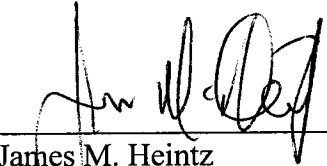
Applicant respectfully disagrees. Claim 54 recites “revision” and the final office action is improperly conflating “revision” with “replacement.” Simply put, sending all new data to a user is replacing a content list, not revising it. The transmission of a content list with completely new material as set forth in the scenario of the final office action is no more a revision than is the substitution of a literary work such as “War and Peace” with an entirely different work such as “Catcher in the Rye.” “Revise” is defined as “to prepare a newly edited version (of a text).” The American Heritage Dictionary (4th ed. 2000). However, a content list with all new data is not a newly edited version of a prior content list because there is nothing in common between the two. Accordingly, the rejection of claim 54 should be withdrawn.

Claim 69 includes similar limitations and was rejected for similar reasons. Therefore, applicant respectfully submits that claim 69 defines patentable subject matter for at least the reasons

discussed above. Moreover, the Hanson reference does not cure any of the deficiencies identified above. Accordingly, applicant respectfully submits that all currently pending rejections should be withdrawn and hereby requests the same.

Respectfully submitted,

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